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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,892	08/29/2001	Eric D. Anderson	500247.03	2384
7590	12/28/2006			
Mark W. Roberts, Esq. DORSEY & WHITNEY LLP Suite 3400 1420 Fifth Avenue Seattle, WA 98101			EXAMINER	
			ENGLAND, DAVID E	
			ART UNIT	PAPER NUMBER
			2143	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		12/28/2006	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/943,892	ANDERSON, ERIC D.
	<b>Examiner</b>	<b>Art Unit</b>
	David E. England	2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 29 September 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 30,32-36 and 45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 30,32-36 and 45 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 30 December 2005 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date: _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>09/29/2006</u> <i>DC</i> | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

1. Claims 30, 32 – 36 and 45 are presented for examination.

### *Drawings*

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “*controlling messages action instructions for the single copy of the email communication by any one of the plurality of recipients, the message action instructions including at least one of deleting, saving, and forwarding.*” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. **It is noted** that the Specification teaches these embodiments in Figures 6 and 7 yet in the Application, Figures 6 and 7 are Not present. Applicant is asked to remedy this oversight that could overcome this Objection.

*Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 30, 33 – 35 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon (6067561) in view of Arnold (6275848) and what is well known in the art.**

6. Referencing claim 30, as closely interpreted by the Examiner, Dillon teaches a computer-implemented method for one of a plurality of designated recipients of an Email communication to receive the Email, comprising:

7. receiving on a recipient's computer an Email communication notification from the server that references the single copy of the Email communication, the Email communication

notification distinct from the Email communication, (e.g. col. 1, line 25 – col. 2, line 38 & col. 3, line 12 – 65);

8. requesting from the server the referenced Email communication, the request being sent to the Email communication program from the recipient's computer system, (e.g. col. 1, line 25 – col. 2, line 38 & col. 3, line 12 – 65), but does not specifically teach providing an Email communication program on a server that is configured with instructions to store a single copy of the Email communication on the server if the Email communication is designated for the plurality of recipients;

9. receiving by the recipient's computer system from the server, the requested Email communication.

10. Arnold teaches providing an Email communication program on a server that is configured with instructions to store a single copy of a section of the Email communication on the server if the Email communication is designated for the plurality of recipients, (e.g. col. 3, line 57 – col. 4, line 42);

11. receiving by the recipient's computer system from the server, the requested section of the Email communication, (e.g. col. 3, line 57 – col. 4, line 42); and

12. controlling message action instructions for the single copy of the Email communication by any one of the plurality of recipients, the message action instructions including at least one of deleting, saving, (e.g., col. 4, lines 43 – 57, *"Such deletion from the access list may occur at the instruction of the recipient or may occur automatically after first access... Once the access list goes to null (i.e., all the intended recipients are deleted from the access list), the attachment is deleted from the server"* & col. 5, lines 36 – 44, *"a sender of a message may define the access*

*rights of the remotely-located attachment. For example, access may be limited to only those recipients of the e-mail message. The rights may include read only; read and save only... The attachments may also be subject to access control rights designated by entities other than the sender of the message. ”). It is also reminded to the Applicant that it is well known in the art that the sender of an email can CC: or BCC: themselves and therefore also become a recipient.*

13. It would have been obvious to one skilled in the art at the time the invention was made to combine Arnold with Dillon because it would be more efficient to conserve space with having one central location, having users reference the single copy of the email then having multiple copies of an attachment taking up substantial space. Furthermore, it is more convenient for a user to have a local copy of an Email so incase the user is off line and wants to modify the local copy of the attachment, the user could with out modifying the original attachment that could be used as an archived document for reference if desired. Arnold does not specifically teach storing a single copy of an email message. It would have been obvious to one of ordinary skill in the art to store a single copy of an email instead of just an attachment since it is well known in the art that an email is nothing more than a message or document sent between users and it would only take one of ordinary skill in the art to, instead of storing a single copy of an attachment, which can also be considered a message, storing a single copy of an email utilizing the teachings of Arnold's criteria for storing a single copy of a message or document. Arnold teaches adding users to the access list, which would allow a new user rights to view the document but does not specifically teach forwarding, (e.g. col. 5, lines 51 – 57, “*a recipient may be added if certain modification rules are met.* ”). Forwarding electronic messages to another user in an email system is well known in the art at the time the invention was made and would only take one of

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ordinary skill in the art to forward the electronic message to a new users and add them to an access list, which would give the user the ability to view the document saved in a storage device.

14. As per claim 33, Dillon does not specifically teach storing the Email communication locally by the recipient on the recipients computer system such that the local stored Email communication is preserved even when the Email communication program deletes the single stored copy of the Email communication from the server.

15. Official Notice is taken that it was a common practice to store the Email communication locally by the recipient on the recipients computer system such that the local stored Email communication is preserved even when the Email communication program deletes the single stored copy of the Email communication from the server at the time the instant invention was made.

16. It would have been obvious to one having ordinary skill in the computer art at the time of the invention was made to modify the method disclosed by Dillon because of similar reasons stated above. Furthermore, if the user saves the Email locally on one computer and disconnects from the network and then logs in on a different computer and deletes the Email on the server there is no way for the Email to be deleted on the first computer. Also if the user were to save the Email on a floppy disk and then delete the Email form the server, the server cannot delete the Email on the floppy disk, especially if the floppy disk is removed.

17. Applicant has failed to seasonably challenge the Examiner's assertions of well known subject matter in the previous Office action(s) pursuant to the requirements set forth under MPEP §2144.03. A "seasonable challenge" is an explicit demand for evidence set forth by Applicant in

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the next response. Accordingly, the claim limitations the Examiner considered as "well known" in the first Office action, i.e. "storing the Email communication locally by the recipient on the recipients computer system such that the local stored Email communication is preserved even when the Email communication program deletes the single stored copy of the Email communication from the server," are now established as admitted prior art of record for the course of the prosecution. See *In re Chevenard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943).

18. As per claim 34, as closely interpreted by the Examiner, Dillon teaches the Email communication received from the server is encrypted using a public encryption key for the one of the plurality of designated recipients, and including retrieving a private encryption key for the one of the plurality of designated recipients to decrypt the Email communication, (e.g. col. 9, line 60 – col. 10, line 15).

19. As per claim 35, as closely interpreted by the Examiner, Dillon and Arnold teach all that is similar in nature to claims 30 and 34, more specifically, Dillon teaches the acts of receiving the notification, requesting the Email communication and receiving the Email communication are performed by a receiving computer lacking sufficient permanent storage to store the Email communication, (e.g. col. 1, line 25 – col. 2, line 38 & col. 3, line 12 – 65).

20. Claim 45 is rejected for similar reasons as stated above.

**21. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon and Arnold in further view of Devine et al. (6385644) (hereinafter Devine).**

22. As per claim 32, as closely interpreted by the Examiner, Dillon and Arnold do not specifically teach receiving the Email communication notification, storing the Email communication notification locally on the recipients computer system.

23. Devine teaches receiving the Email communication notification, storing the Email communication notification locally on the recipients computer system, (e.g. col. 12, lines 40 – 55). It would have been obvious to one skilled in the art at the time the invention was made to combine Devine with the combine system of Dillon and Arnold because of similar reasons stated above and further, if a user has a personal records of Email communication notifications it could prevent loss of information if the server were to break down and/or crash, (i.e. redundancy).

**24. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon and Arnold and in further view of Homan et al. (6317485).**

25. Referencing claim 36, as closely interpreted by the Examiner, Dillon and Arnold do not specifically teach wherein contents of the received Email communication notification are based on preferences for the one of the plurality of designated recipients, the preferences previously supplied to the server configured with the Email communication program. Homan teaches wherein contents of the received Email communication notification are based on preferences for the one of the plurality of designated recipients, the preferences previously supplied to the server

configured with the Email communication program, (e.g. col. 6, lines 28 – 49 & col. 7, lines 1 – 44). It would have been obvious to one skilled in the art at the time the invention was made to combine Homan with the combine system of Dillon and Arnold because of similar reasons stated above and further it would be more efficient for a system to utilize a type of preference setting to classify or possibly utilize different types of Email communication notifications. This will diversify the way a user may receive notifications about incoming Email.

***Response to Arguments***

26. Applicant's arguments filed 09/29/2006 have been fully considered but they are not persuasive.

27. In the Remarks, Applicant argues in substance that the prior art of Dillon and Arnold do not teach the newly added limitation of "controlling messages action instructions for the single copy of the email communication by any one of the plurality of recipients, the message action instructions including at least one of deleting, saving, and forwarding," nor the newly added claim 45.

28. As to the Applicant's arguments, Examiner respectfully disagrees with the Applicant and has stated the newly cited areas of the prior art that clearly teaches, in combination to what is well known in the art, the newly added claim limitation. Arnold not only teaches the act of deleting, saving and forwarding in view of what is well known in the art as cited above but the Applicant's specification states the same manner of deleting a message as cited by the prior art,

(quoting Applicant's specification, "*In one embodiment, after all recipients have reviewed the message and no recipient has currently indicated to save the message (or all have indicated to delete the message), the MDS system deletes the single copy of the message.*")<sup>1</sup>). Such is the same with Arnold with the access list and waiting for all recipients to be listed as seen document or delete document before the document can be deleted.

29. As for Claim 45 it has substantially similar limitations as claim 30 and was rejected for similar reasons.

### *Conclusion*

30. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. England whose telephone number is 571-272-3912. The examiner can normally be reached on Mon-Thur, 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

David E. England  
Examiner  
Art Unit 2143

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EXAMINER